

## REMARKS

Applicants acknowledge receipt of an Office Action dated December 31, 2003. In this response, Applicants have amended claims 1 and 24 to correct a typographical error noted in the Office Action. Following entry of this amendment, claims 1-13, 15, 16 and 18-29 remain pending in the application.

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

### Claim Objections

On page 2 of the Office Action, the PTO has objected to a typographical error in claims 1 and 24. In this response, Applicants have amended claims 1 and 24 as suggested by the PTO. Accordingly, Applicants submit that the objections to claims 1 and 24 are now moot.

### Rejections Under 35 U.S.C. §103

On page 2 of the Office Action, the PTO has rejected claims 1-10, 12-13, 15-16, 18-21 and 23-27 under 35 U.S.C. §103 as being unpatentable over DE 4438961 to Hammer *et al.* (hereafter “Hammer ‘961”). In addition, on page 4 of the Office Action, the PTO has rejected claims 11, 22 and 28-29 under 35 U.S.C. §103(a) as being unpatentable over Hammer ‘961 in view of U.S. Patent 5,679,145 to Andersen *et al.* (hereafter “Andersen”). The PTO has provided its own English translation of Hammer ‘961. Applicants respectfully traverse these rejections for the reasons set forth below.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143. Here, Applicants submit that Hammer ‘961 fails to teach or fairly suggest an

edible shaped body as set forth in independent claim 1, and the PTO has failed to establish any proper motivation for modifying Hammer '961.

As an initial matter, Applicants note that Hammer '961 is the German priority document for U.S. Patent 5,928,737 which was cited in the previous Office Action. As in U.S. Patent 5,928,737, Hammer '961 discloses biodegradable sausage casings which are produced by extrusion, but Hammer '961 fails to disclose edible shaped bodies. Applicants note that a prior art reference must be considered in its entirety, *i.e.*, as a whole. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Here, Applicants submit that a reading of Hammer '961 as a whole would lead one skilled in the art to recognize that Hammer '961 relates to inedible biodegradable sausage casings instead of the presently claimed edible shaped bodies.

In describing the problems with the sausage casings of the prior art, Hammer '961 notes that the casings of the prior art "are not biodegradable and are thus expensive to dispose of". (Last full paragraph on page 2 of the PTO's translation of Hammer '961). Hammer '961 then states that the sausage casings according to his invention should "be biodegradable". (Paragraph bridging pages 2 and 3 of the PTO's translation of Hammer '961).

In addition, each of the 4 Examples in Hammer '961 evaluated the removability of the casing. The evaluation of the removability of the casing from the sausage taken in light of Hammer '961's comments regarding biodegradability and disposal of the used sausage casings would lead one skilled in the art to conclude that Hammer '961 relates to inedible sausage casings.

Applicants also note that the sausage casing according to Example 2 of Hammer '961 shows an elongation at break (in the dry state) of about 80 % in longitudinal direction and about 100 % in cross direction. The non-fiber-reinforced casing according to Example 3 of the reference shows an elongation at break which is only slightly less than that. In contrast, the edible shaped bodies of the presently claimed invention have an elongation at break (in the dry state) of about 15 % or less in the longitudinal direction and about 20 % in the cross direction. It is commonly known to those skilled in the pertinent art that casings with an elongation at break (in the dry state) in the range of the casings of Hammer '961 are no longer chewable and hence cannot be regarded as "edible".

The casings of Hammer '961 are intended in particular for salami and other long-lasting sausages. This requires a strong casing having a high wall thickness, which, as discussed above, is easily peelable. Edibility is not an issue. The casings specifically disclosed in Hammer '961 have a wall thickness of 90  $\mu\text{m}$  (Example 1), 85  $\mu\text{m}$  (Example 2), 108  $\mu\text{m}$  (Example 3) or 95  $\mu\text{m}$  (Example 4), which renders them non-edible. Thus, Hammer '961 does not teach or suggest an edible shaped body in the form of a flat or tubular film with a wall thickness of from 20 to 60  $\mu\text{m}$ .

In the last full paragraph on page 5 of the Office Action, with regard to the meaning of the term "edible," the PTO stated that "Applicant is respectfully reminded that animals eat the bark of trees." Applicants recognize that, during examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Here, Applicants submit that the PTO has failed to interpret the term "edible" reasonably. Claim terms must be read as they would be interpreted by those of ordinary skill in the art. *In re Sneed*, 710 F.2d 1544, 218 USPQ 385 (Fed. Cir. 1983). Applicants submit that those skilled in the sausage casing art would readily recognize the difference between edible casings and inedible casings (which are peeled away from the sausage and discarded), and Applicants further submit that one skilled in the art would readily recognize that Hammer '961 relates to inedible sausage casings (as evidenced, for example, by the discussion of biodegradability of the casing after disposal, the peelability/removability of the casing and the casing wall thickness).

Applicants further submit that, from a reading of Applicants' specification as a whole, the term "edible" is clearly intended to mean "edible by human beings."

For these reasons, Applicants submit that Hammer '961 fails to teach or properly suggest edible sausage casings and that the PTO has failed to establish any proper motivation to modify Hammer '961 in a manner that would render the sausage casings edible. Accordingly, Applicants submit that the rejection of claims 1-10, 12-13, 15-16, 18-21 and 23-27 under §103 is improper and should be withdrawn.

If an independent claim is nonobvious under §103, then any claim depending therefrom is nonobvious. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). See MPEP 2143.03. Thus, Applicants submit that claims 2-10, 12-13, 15-16, 18-21 and 23-27, which ultimately depend from independent claim 1, are also non-obvious.

With respect to the rejection of claims 11, 22 and 28-29, the PTO has combined Hammer '961 with Andersen. The PTO has combined Andersen with Hammer '961 because Andersen allegedly "teaches the equivalency of woodpulp fibers with cotton linters in the capacity of fiber reinforcement of starch". The articles disclosed by Andersen, namely packaging materials and containers, are non-edible, like the sausage casings of Hammer '961. They have a starch-bound foamed cellular matrix reinforced with dispersed fibers. (See abstract). The fibers improve the toughness and the form stability of the article (col. 73, lines 32 and 33). This is just the opposite of what is desired for an edible article. An edible article must not be tough. It rather needs to be chewable. Andersen does not provide any motivation to incorporate fibers in an edible article. The combination of Hammer '961 with Andersen hence could not have rendered obvious the presently claimed edible article. Thus, Andersen fails to resolve the basic deficiencies in Hammer '961 which have been outlined above. As a result, neither Hammer '961 nor Andersen, taken either individually or in combination, teach or properly suggest the presently claimed edible shaped body.

With particular regard to claims 28 and 29, Applicants note that neither Hammer '961 nor Andersen, taken either individually or in combination, teach or properly suggest either a shaped body exhibiting either longitudinal elongation at break of 12-15% or a transverse elongation at break of 20-26%. Applicants note that the PTO did not specifically address either of these claims in the last Office Action. Applicants respectfully request that the PTO specifically address each of these claims in the next Office Action.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of this rejection under §103.

#### **CONCLUSION**

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or

even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 4/30/09

By 

FOLEY & LARDNER LLP  
Customer Number: 22428  
Telephone: (202) 672-5540  
Facsimile: (202) 672-5399

Richard L. Schwaab  
Attorney for Applicants  
Registration No. 25,479

Paul D. Strain  
Agent for Applicants  
Registration No. 47,369